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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,483

11/21/2003

Taylor James

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EXAMINER

ORTIZ, BELIX M

ART UNIT

PAPER NUMBER

2164

MAIL DATE

DELIVERY MODE

11/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/719,483	JAMES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	BELIX M. ORTIZ	2164	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Remarks**

1. In response to communications files on 18-September-2008. Claims 1-35 are cancelled and claims 36-41 are added per applicant request. Claims 36-41 are presently pending in the application.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/18/2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Claims 36 and 40-41 recites “ a selection indicator”, which is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art the inventor(s), at the time application was filed, had possession of the claimed invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 36 and 40-41 recites the limitation "the selection indicators" in lines 9, 11, 12, and

14. There is insufficient antecedent basis for this limitation in the claim.

Claims 36 and 40-41 recites the limitation "search results" in lines 10, 12, 18, and 19.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 36-41 are rejected under 35 U.S.C. 101 because as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is: it is not clear that a computer or hardware is been use.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 36-37 and 40-41 are rejected under 35 U.S.C. 103(a) (Eff. Filing date of application: 11/21/02) as being unpatentable by Hoch (U.S. Pub. 2003/0191753) (Eff. Filing date: 4/8/2002) in view of Ehrlich et al. (U.S. patent 2002/0156685) ( Eff. filing date of application: 2/10/2001).

As to claims 36, 40 and 41, Hoch teaches a method of saving search results (see abstract), the method comprising operations of:

receiving a query from a user (see fig. 6, character 601);

in response to receiving a user selection of one or more of the selection indicators, saving in association with the query any search results associated with the selected selection indicators and discarding any search results unassociated with the selected selection indicators (see fig. 6, character 603);

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subsequent to receiving the user selection of the one or more of the selection indicators, receiving a user request including at least an identification of the query (see fig. 6, character 604); and

in response to receiving the user request, conducting a new search according to said query and presenting the user with the following items in association with each other: a set of new search results satisfying the query, and the original set of search results saved in association with the query (see fig. 6, character 606).

Hoch does not expressly teach in response to receiving the query, conducting a search according to the query and presenting an original set of search results to the user, wherein each search result in the original set is presented in association with a selection indicator that is selectable by the user to save the associated search result.

Ehrlich teaches system and method for automating electronic commerce transactions using a virtual shopping cart (see abstract), in which he teaches in response to receiving the query, conducting a search according to the query and presenting an original set of search results to the user, wherein each search result in the original set is presented in association with a selection indicator that is selectable by the user to save the associated search result (see paragraphs 5 and 73).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hoch by the teaching of Ehrlich et al., because in response to receiving the query, conducting a search according to the query and presenting an original set of search results to the user, wherein each search result in the original set is

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presented in association with a selection indicator that is selectable by the user to save the associated search result, would enable the method because, “A typical search engine has an interface with a search window where the shopper enters an alphanumeric search expression or keywords. The search engine sifts through available web sites for the shopper's search terms, and returns the search of results in the form of HTML pages. Each search result includes a list of individual entries that have been identified by the search engine as satisfying the shopper's search expression. Each entry or "hit" may include a hyperlink that points to a Uniform Resource Locator (URL) location or web page”, (see paragraph 5).

As to claim 37, Hoch as modified teaches the method the operations performed in response to receiving the user request include presenting the saved search results above the set of new search results satisfying the query (see Ehrlich, fig. 3A “340” and paragraphs 5-6).

8. Claims 38-39 are rejected under 35 U.S.C. 103(a) (Eff. Filing date of application: 11/21/02) as being unpatentable by Hoch (U.S. Pub. 2003/0191753) (Eff. Filing date: 4/8/2002) in view of Ehrlich et al. (U.S. patent 2002/0156685) (Eff. filing date of application: 2/10/2001) and further in view of Bowen (U.S. Pub. 2003/0036927) (Eff. Filing date: 8/15/2002).

As to claim 38, Hoch as modified does not teach the method the operations performed in response to receiving the user request further include ordering the search results of the new set and the original set in chronological order.

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Bowen teaches a search system and user interface (see abstract) in which he teaches the method the operations performed in response to receiving the user request further include ordering the search results of the new set and the original set in chronological order (see paragraph 71).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hoch by the teaching of Bowen, because method the operations performed in response to receiving the user request further include ordering the search results of the new set and the original set in chronological order, would enable the method to display the most recent search result first.

As to claim 39, Hoch does not teach the method further comprising the operation of: responsive to receiving user designation of one or more selected search results from the original set or the new set or both, transferring said selected search results to a nonvolatile bookmarks list to preserve information related to said selected search results after a current search session ends.

Bowen teaches a search system and user interface (see abstract) in which he teaches the method further comprising the operation of: responsive to receiving user designation of one or more selected search results from the original set or the new set or both, transferring said selected search results to a nonvolatile bookmarks list to preserve information related to said selected search results after a current search session ends (see paragraph 76).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Hoch by the teaching of Bowen, because the method



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further comprising the operation of: responsive to receiving user designation of one or more selected search results from the original set or the new set or both, transferring said selected search results to a nonvolatile bookmarks list to preserve information related to said selected search results after a current search session ends, would enable the method have a faster access and to save the search results for future access.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Belix M. Ortiz whose telephone number is 571-272-4081. The examiner can normally be reached on moday-friday 9am-5pm. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/BMO/

Examiner of Art Unit 2164

November 18, 2008

/Charles Rones/

Supervisory Patent Examiner, Art Unit 2164